

Application No. 10/074,356  
Amendment dated December 7, 2004  
Reply to Office Action dated September 8, 2004

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the Official Action of the Examiner mailed September 8, 2004, setting a shortened statutory period for response ending December 8, 2004. Claims 1-3, 6-14, 16-24, 26-50 remain pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

As a preliminary matter, Applicant electronically filed (efiled) an IDS on August 31, 2004. However, an initialed copy of the submitted FORM-1449 was not included with the Office Action. *Applicant respectfully requests that the Examiner provide an initialed copy of the FORM-1449 submitted on August 31, 2004 in due course.*

In paragraph 2 of the Office Action, the Examiner rejected claims 1-3, 6-14, 16-21, 23, 24 and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over Burkitt (U.S. Patent No. 5,680,496) in view of Bell (U.S. Patent No. 5,410,458). On page 7 of the Office Action, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the slit of Bell in the elongated member of Burkitt to be able to easily remove the light source in the event that it needs service or replacement (citing Bell, column 3, lines 51-55). The Examiner also states that it would have further been obvious to place such a slit on the side facing the elongated carrier for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member. The Examiner also states that such an arrangement would inherently force the elongated carrier to provide a latching function with a closing force to the slit.

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After careful review, Applicant must respectfully disagree for a variety of reasons.

Turning first to claim 1, which now recites:

1. (Currently Amended) An elongated light for receiving an elongated light source, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, wherein at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member;

an elongated carrier, the elongated carrier having a back side and two side walls, wherein the side walls define a slot that is spaced from the back side of the carrier for receiving at least part of the elongated member, the slot and elongated member being adapted so that the elongated member must be at least partially elastically deformed or bent to insert the elongated member into the slot the elongated member having a back portion that faces the back side of the elongated carrier when the elongated member is received by the slot, and the elongated slit of the elongated member extends into the cavity of the elongated member through the back portion of the elongated member.

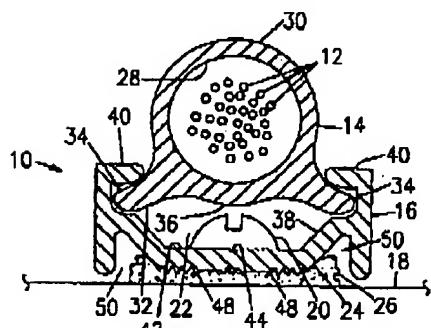
As can be seen, claim 1 recites an elongated carrier that has a back side and two side walls, wherein the side walls define a slot that is spaced from the back side of the carrier for receiving at least part of the elongated member. Claim 1 also recites that the elongated member has a back portion that faces the back side of the elongated carrier when the elongated member is received by the slot, and the elongated slit of the elongated member extends into the cavity of the elongated member through the back portion of the elongated member.

On page 7 of the Office Action, and as noted above, the Examiner concluded that it would have been obvious to place the slit of Bell on the side facing the elongated carrier of Burkitt for presenting a continuous and uniform output surface and for preventing the light

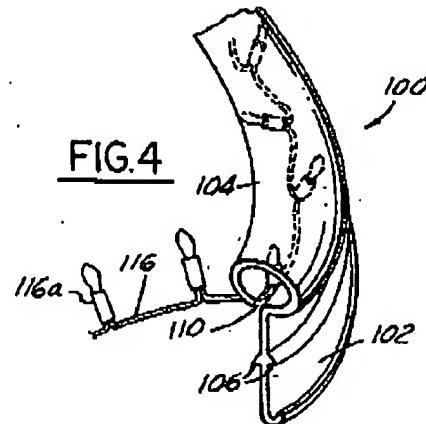
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source from being accidentally removed from the elongated member. Applicant must respectfully disagree.

For the Examiner's convenience, Figure 2 of Burkitt and Figure 4 of Bell are reproduced below:



*FIG. 2*



Bell state:

The illuminated landscape edging 100 is composed of a planar member 102 which is structured to be implanted into the ground and by a tubular member 104 which is structured to be located above ground. The planar member 102 is preferably provided with a medial ribbing 106 and also preferably provided with an end hook 108, both of which optionally taking on any form suitable for serving to anchor the planar member into the ground.

(Bell, column 2, lines 58-66). Bell further state that the sidewall of the tubular member 104 is provided with a slit 110 running its length in parallel alignment with the planar member 102, preferably located adjacent the planar member. (Bell, column 3, lines 6-9). Bell further state that

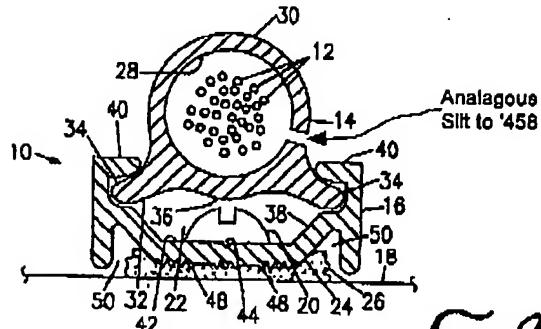
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the lighting string 116 is encapsulated by the tubular member 104, thereby protecting it from injury, and that in the event any of the lights 116a of the lighting string 116 need service, it is a simple matter to access the subject light via the slit 110 in the tubular member 104, and if needed, the slot 114. (Emphasis Added) (Bell, column 3, lines 48-55).

As can be seen, when installed, the planar member 102 extends into the ground and secures the illuminated landscape edging 100 in the ground. As shown in Figure 4 and other Figures of Bell, the slit 110 is positioned on the non-viewing side of the illuminated landscape edging 100, adjacent to the planar member 102 above the ground, so that it is a simple matter to access the subject light via the slit 110 in the tubular member 104 to service the lighting string 116 after the illuminated landscape edging 100 is installed in the ground. Clearly, it would not be a simple matter to service the lighting string 116 if the illuminated landscape edging 100 had to be first removed (i.e. dug up) from the ground.

If Bell were combined with Burkett as the Examiner suggests, Bell would clearly suggest placing the slit 110 somewhere that is accessible from outside of the elongated carrier of Burkitt, such as shown below:

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*Fig. 2*

This example slit arrangement would be consistent with the teachings of Bell. For example, this arrangement would make it a simple matter to access the fiber cable 12 of Burkitt via the slit in the tube 14 to service the fiber cable 12 after the tube 14 is installed in the track 16, without having to remove the tube 14 from the track (which is analogous to not having to remove the illuminated landscape edging 100 from the ground to service the lighting string 116). Nothing in Bell would suggest placing the slit of Bell on the side facing the elongated carrier of Burkitt, as the Examiner suggests, particularly since this would require that the tube 14 be removed from the track 16 before the fiber cable 12 could be serviced, which is directly contrary to the teachings of Bell. Thus, and as can readily be seen, Bell actually teaches away from the arrangement proposed by the Examiner.

The Examiner also states that it would have been obvious to place the slit of Bell on the side facing the elongated carrier of Burkitt for "preventing the light source from being accidentally removed from the elongated member". However, and as noted above, Bell state that

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the lighting string 116 is encapsulated by the tubular member 104, thereby protecting it from injury. That is, Bell teaches that his construction adequately protects the lighting string 116. Thus, there would be no motivation whatsoever to place the slit 110 of Bell on the side facing the elongated carrier of Burkitt for "preventing the light source from being accidentally removed from the elongated member", particularly since it would require that the tube 14 be removed from the track 16 before the fiber cable 12 could be serviced, which is contrary to the teachings of Bell.

In view of the foregoing, claim 1 is believed to be clearly patentable over Burkitt in view of Bell. For similar and other reasons, dependent claims 2-3, 6-9, 35, and 39-42 are also believed to be clearly patentable over Burkitt in view of Bell.

Turning now to claim 10, which recites:

10. (Currently Amended) An elongated light for receiving an elongated light source, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit or opening that extends into the cavity through the elongated member;

an elongated carrier, the elongated carrier having a slot for receiving at least part of the elongated member; and

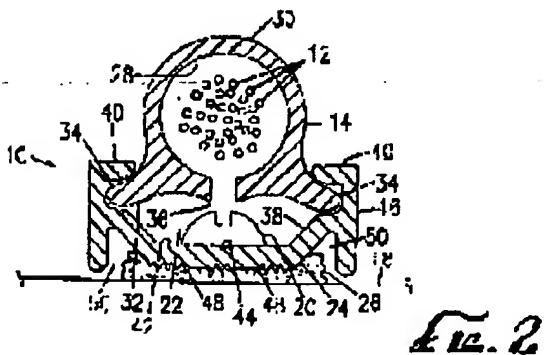
the slot and elongated member are adapted so that when the at least part of the elongated member is received by in the slot, the elongated carrier provides a closing force to the elongated slit or opening of the elongated member.

On page 7 of the Office Action, and if the slit of Bell were placed on the side facing the elongated carrier of Burkitt, the Examiner states that such an arrangement would inherently force the elongated carrier to provide a latching function with a closing force to the slit.

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First, Applicant does not believe such an arrangement would inherently force the elongated carrier to provide a latching function and/or a closing force to the slit, as the Examiner suggests. As noted in MPEP § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill (Emphasis Added). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Applicant has modified Figure 2 of Burkitt to include a slit, as suggested by the Examiner:



As can be seen, and depending on the dimensions and tolerances of the tube 14, the slit, the

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opposing edges 34, and the track 16, the track 16 does not necessarily provide a latching function and/or a closing force to the slit, as the Examiner suggests. The tube may be sized to just fit in the track, with the track not providing a latching function and/or a closing force to the slit. As such, the arrangement proposed by the Examiner clearly does not inherently provide a latching function and/or a closing force, as the Examiner suggests.

In addition, and more importantly, nothing in Bell or Burkitt suggest placing the slit of Bell on the side facing the elongated carrier of Burkitt, as the Examiner suggests, particularly since this would require that the tube 14 be removed from the track 16 before the fiber cable 12 could be serviced, which is directly contrary to the teachings of Bell. In fact, and as detailed above, Bell actually teaches away from such an arrangement. In view of the foregoing, claim 10 is believed to be clearly patentable over Burkitt in view of Bell. For similar reasons, as well as other reasons, dependent claim 36 is also believed to be clearly patentable over Burkitt in view of Bell. For similar and other reasons, independent claim 11, and dependent claims 12-14, 16-18 and 43-46 are also believed to be clearly patentable over Burkitt in view of Bell.

Turning now to claim 19, which recites:

19. (Currently Amended) An elongated light, comprising:
  - an electro-luminescent wire;
  - an elongated member having a length with a cavity, the cavity extending along at least part of the length of the elongated member and being adapted for receiving the electro-luminescent wire; and
  - an elongated slit or opening that extends along at least part of the cavity, the elongated slit or opening extending into the cavity through the elongated member;
  - an elongated carrier, the elongated carrier having a slot for receiving at least part of the elongated member, wherein the elongated slit or opening faces the

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elongated carrier when the at least part of the elongated member is received by the slot.

As can be seen, claim 19 recites that the "elongated slit or opening faces the elongated carrier when the at least part of the elongated member is received by the slot." Thus, for the same reasons discussed above with respect to claim 1, as well as other reasons, claim 19 is believed to be clearly patentable over Burkitt in view of Bell. For similar and other reasons, dependent claim 20, 37, 47-50, and independent claim 21 and dependent claim 38 are also believed to be clearly patentable over Burkitt in view of Bell.

Turning now to claim 23, which recites:

23. (Currently Amended) An elongated light for receiving an elongated light source, the elongated light having a viewing side and a non-viewing side, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit or opening that extends into the cavity through the elongated member, wherein at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member on the viewing side of the elongated light, and at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member also on the viewing side of the elongated light.

The fiber optic cable assembly of Burkitt includes a bundle of fiber optic fibers 12 held within a transparent or translucent tube 14 (Burkitt, column 3, lines 16-20). Thus, the tube of Burkitt is made from just one material, and that material is a transparent or translucent material. Turning now to Bell, which states:

The illuminated landscape edging 100 is composed of a planar member 102 which is structured to be implanted into the ground and by a tubular member 104 which is structured to be located above ground. The planar member 102 is

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preferably provided with a medial ribbing 106 and also preferably provided with an end hook 108, both of which optionally taking on any form suitable for serving to anchor the planar member into the ground. The sidewall of the tubular member 104 is constructed of a light passable material, and may be optionally translucent, colored, clear, frosted, or selectively otherwise, but in any event able to pass light therethrough.

... The planar member 102 and the tubular member 104 are connected together, preferably being mutually integrally connected. Both the planar and tubular members 102, 104 are constructed of plastic. The planar member may or may not be light passable, however as a practical manufacturing matter, both the tubular and planar members 102, 104 may be formed by a standard plastic forming process, wherein both would be constructed of the same plastic material. The illuminated landscape edging 100 is elongated and is preferably provided in long rolls which may be cut into sections to suit the length needs of a particular landscaping job, as for instance shown in FIG. 2 (Emphasis Added).

(Bell, column 2, line 58 through column 3, line 23). Thus, in Bell, the tubular member 104 is constructed of a light passable material. Bell does state that the planar member 102 may or may not be light passable. However, the planar member 102 is "structured to be implanted into the ground", and therefore is not on the viewing side of the elongated light, as recited in claim 23

Bell further states:

A light passing tubular member is the most preferred form of illuminated landscape edging 100. However, as shown in FIG. 6, an alternative form of the illuminated landscape edging 100' may utilize a tubular member 104' that is conventionally opaque, but is provided with a plurality of discrete holes 122 running periodically placed along its length through which the illumination from the lighting string 116 shines.

(Bell, column 3, lines 61-68). However, in this embodiment, at least part of the cavity is not defined by an at least semi-transparent material that extends from the cavity to an outer surface of

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the elongated member on the viewing side of the elongated light, as recited in claim 23.

In view of the foregoing, neither Burkitt or Bell disclose or suggest an elongated member having a cavity for receiving the elongated light source and an elongated slit or opening that extends into the cavity through the elongated member, wherein at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member on the viewing side of the elongated light, and wherein at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member also on the viewing side of the elongated light, as recited in claim 23. In view of the foregoing, claim 23 is believed to be clearly patentable over Burkitt in view of Bell.

Turning now to claim 24, which recites:

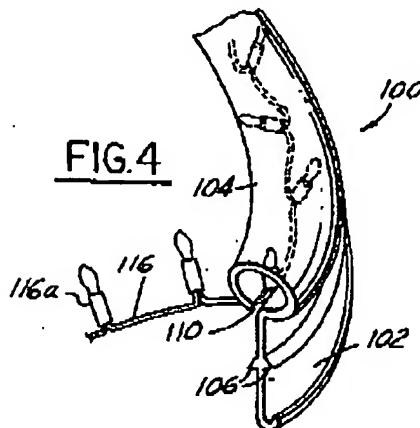
24. (Currently Amended) An elongated light for receiving an elongated light source, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit with a length that extends into the cavity through the elongated member, the elongated slit being defined by two slit defining surfaces wherein at least part of the two slit defining surfaces are touching one another over a majority of the length of the slit; and

wherein at least part of the cavity is defined by an at least semi-transparent material that extends from the cavity to an outer surface of the elongated member, and at least part of the elongated member includes a non-transparent material between the cavity and an outer surface of the elongated member.

The slit of 110 of Bell is defined by two slit defining surfaces that are spaced along their length to form a gap, as can clearly be seen in Figure 4 of Bell - which is reproduced below:

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Clearly, Bell does not suggest an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member, wherein the elongated slit is defined by two slit defining surfaces wherein at least part of the two slit defining surfaces are touching one another over a majority of the length of the slit, as recited in claim 24. Burkett adds nothing in this regard. For these and other reasons, claim 24 is believed to be clearly patentable over Burkitt in view of Bell.

Turning now to claim 30, which recites:

30. (Currently Amended) An elongated light for receiving an elongated light source, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit that extends into the cavity through the elongated member;

an elongated carrier, the elongated carrier having a slot for receiving at least part of the elongated member, the slot and elongated member being adapted so that the elongated member must be is at least partially elastically deformed or bent when to insert the elongated member is inserted into the slot; and

wherein the slot and elongated member are adapted so that when the at least part of the elongated member is in the slot, the elongated carrier provides a closing force to the elongated member to help keep the slit in the elongated

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member in a closed or substantially closed position.

As can be seen, claim 30 recites that the elongated carrier provides a closing force to the elongated member to help keep the slit in the elongated member in a closed or substantially closed position. For similar reasons to those discussed above with respect to claim 10, as well as other reasons, claim 30 is believed to be clearly patentable over Burkitt in view of Bell.

Turning now to claim 31, which recites:

31. (Currently Amended) An elongated light for receiving an elongated light source, the elongated light having a viewing side and a non-viewing side, comprising:

an elongated member having a cavity for receiving the elongated light source and an elongated slit or opening that extends into the cavity through the elongated member, the elongated slit or opening being located on a non-viewing side of the elongated light elongated member, at least part of the elongated member includes a transparent material between the cavity and an outer surface of the elongated member on the viewing side of the elongated light and a non-transparent material between the cavity and an outer surface of the elongated member also on the viewing side of the elongated light.

As can be seen, claim 31 recites that at least part of the elongated member includes a transparent material between the cavity and an outer surface of the elongated member on the viewing side of the elongated light and a non-transparent material between the cavity and an outer surface of the elongated member also on the viewing side of the elongated light. Thus, for similar reasons to those discussed above with respect to claim 23 above, as well as other reasons, claim 31 and dependent claims 32-34 are believed to be clearly patentable over Burkitt in view of Bell.

In paragraph 6 of the Office Action, the Examiner indicated that claims 22 and 26-30 are allowed.

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In view of the foregoing, it is believed that all pending claims 1-3, 6-14, 16-24, 26-50 are in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the undersigned attorney at (612) 359-9348.

Respectfully submitted,

  
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Dated: December 7, 2004

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